



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/578,913

05/09/2006

Akihiro Tanaka

2006_0620A

4446

52349

7590

03/25/2010

WENDEROTH, LIND & PONACK L.L.P.

1030 15th Street, N.W.

Suite 400 East

Washington, DC 20005-1503

EXAMINER

KHAN, ASHER R

ART UNIT

PAPER NUMBER

2621

NOTIFICATION DATE

DELIVERY MODE

03/25/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com

coa@wenderoth.com

DETAILED ACTION

Election/Restrictions

Claim 18 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subcombination, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/27/2009.

Applicant's election without traverse of 1-17, 19-22, 24, 25 and 27 in the reply filed on 10/27/2009 is acknowledged.

Response to Arguments

Applicant's arguments filed 07/08/2009 have been fully considered but they are not persuasive.

In re page 17 applicants argues that Terada fails to disclose Terada discloses a content reproduction device that reproduces a stream media content that is linked to from a multimedia content written in markup language used for web browsing, wherein a state of the reproduction of the stream media content can be changed according to an instruction by a user and the reproduction of the stream media content is performed for a predetermined consecutive period of time, the content reproduction device comprising:

a display unit operable to display the multimedia content (a reproducing unit operable to reproduce the stream media content that is linked to from displayed multimedia content; a reproduction state change accepting unit operable to accept, from the user, reproduction state change information indicating a change in the state of the reproduction state of the stream media content by the reproduction unit.

In response the Examiner respectfully disagrees. Terada discloses Terada discloses a content reproduction device that reproduces a stream media content (Col. 9 lines 1-15; Fig. 3) that is linked to from a multimedia content (Fig. 2) written in markup language (Col. 1 lines 30-40; Col. 8 lines 20-39; world wide web servers are used to host sites or websites which contain web pages which are written in markup language. While URLs are addresses to connect the host sites) used for web browsing, wherein a state of the reproduction of the stream media content can be changed according to an instruction by a user and the reproduction of the stream media content is performed for a predetermined consecutive period of time, the content reproduction device comprising:

a display unit operable to display the multimedia content (Fig. 4; Col. 8 lines 20-39; Col. 9 lines 41-67, Col. 10 lines 1-3)

a reproducing unit operable to reproduce the stream media content that is linked to from displayed multimedia content (Fig. 4; Col. 8 lines 20-39; Col. 9 lines 41-67, Col. 10 lines 1-3);

a reproduction state change accepting unit operable to accept, from the user, reproduction state change information indicating a change in the state of the reproduction state of the stream media content by the reproduction unit (Col. 3, lines 51-55; reproduction change to fast forward or rewind of a content being currently reproduced).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 2621

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 21 and 22 are directed to a "computer-readable recording medium". As described in paragraph 0014 program can be distributed through transmission medium. Therefore to overcome the 101, the "computer-readable recording medium" should be changed to "non-transitory computer-readable recording medium"

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

Art Unit: 2621

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification does not disclose “a return position determining unit operable to determine, based on the reproduction state change information and based on whether (i) all of the stream media content has been reproduced by the reproducing unit or (ii) only a portion of the stream media content has been reproduced by the reproducing unit a return position indicating a portion of the multimedia content to be displayed when transitioning from reproducing the stream media content back to displaying the multimedia content when the reproduction of the stream media content by the reproducing unit has ended, wherein the display unit is operable to display the portion of the multimedia content indicated by the return position”. Specification only discloses “a return position determining unit which determines, according to the reproduction state change information accepted by the reproduction state change accepting unit, a return position in the multimedia content for a transition after the reproduction of the stream media content is ended, wherein the display unit displays the multimedia content located in the determined return position” in paragraph 0006 of published application.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2621

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1-6, 7-9, 11-15, 17, 19-22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,113,983 B1 to Terada et al "Terada".

As to claims 1, 19 and 21, Terada discloses a content reproduction device that reproduces a stream media content (Col. 9 lines 1-15; Fig. 3) that is linked to from a multimedia content (Fig. 2) written in markup language (Col. 1 lines 30-40; Col. 8 lines 20-39; world wide web servers are used to host sites or websites which contain web pages which are written in markup language. While URLs are addresses to connect the host sites) used for web browsing, wherein a state of the reproduction of the stream media content can be changed according to an instruction by a user and the reproduction of the stream media content is performed for a predetermined consecutive period of time, the content reproduction device comprising:

a display unit operable to display the multimedia content (Fig. 4; Col. 8 lines 20-39; Col. 9 lines 41-67, Col. 10 lines 1-3)

a reproducing unit operable to reproduce the stream media content that is linked to from displayed multimedia content (Fig. 4; Col. 8 lines 20-39; Col. 9 lines 41-67, Col. 10 lines 1-3);

a reproduction state change accepting unit operable to accept, from the user, reproduction state change information indicating a change in the state of the reproduction state of the stream media content by the reproducing unit (Col. 3, lines 51-

Art Unit: 2621

55; reproduction change to fast forward or rewind of a content being currently reproduced); and

a return position determining unit operable to determine, according to the reproduction state change information accepted by said reproduction state change accepting unit (Change from normal reproduction to Fast forward or Fast rewind), a return position (URL for the content) in the multimedia content for a transition after the reproduction of the stream media content is ended (client device acquires another content that precedes or follows and reproduces contents and ends reproduction of currently reproduced by fast forwarding or reversing), wherein said display unit is operable to display the multimedia content located in the determined return position (Figs. 3, 6a-6c; Col. 3, lines 50-67; Col. 4, lines 1-3; Col. 11 lines 31-52).

As to claims 2, 20 and 22, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the return position determining unit is operable to obtain a transition condition table (program file, Fig. 3) describing a relationship between the state of the reproduction of the stream media content (preceding or following contents are being fast forwarded or fast rewound or currently played) and the return position (content URL), and to determine the return position (content URL) based on the transition condition table and the reproduction state change information (Fig. 3; Col. 12, line 47-60).

As to claim 3, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses comprising a storing unit in which the multimedia content (Fig. 3, program file with contents), the stream media content (Fig. 3, contents), e

Art Unit: 2621

transition condition table (Program file) and accepted reproduction state change information (Command of fast forward is given and is thus accepted and stored) are stored, wherein the reproducing unit is operable to reproduce the stored stream media content, wherein the display unit is operable to display the stored multimedia content, and wherein the return position determining unit is operable to determine the return position based on the stored transition condition table and the stored reproduction state change information (Figs. 3;Col. 3, lines 50-67;Col. 4, lines 1-3).

As to claim 4, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, further comprising a receiving unit operable to receive, from a server via a network (Fig. 1), the multimedia content, the stream media content and the transition condition table, wherein the reproducing unit is operable to reproduce the received stream media content, where in the display unit (Fig. 5) is operable to display the received multimedia content, and wherein the return position determining unit is operable to determine the return position based on the received transition condition table and the accepted reproduction state change information (Figs. 3;Col. 3, lines 50-67;Col. 4, lines 1-3).

As to claims 5 and 24, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the return position includes at least two different URLs (Figs. 3 and 8).

As to claim 6, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, wherein the reproduction state change information includes at least one of, stop or fast-forward, rewind and pause as the change in the

Art Unit: 2621

state of the reproduction (Col. 3 lines 50-67; Col. 16 lines 49-67 and col. 17 lines 1-2), and includes time information indicating a time when the change in the state of the reproduction is made (Fig. 8, reproduction timing), and wherein the return position determining unit is operable to determine, with reference to the state of the reproduction that corresponds to the time information, the return position based on whether or not a transition condition described in the transition condition table is satisfied (Col. 3 line 50-67).

As to claim 8, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein at least a first content and a second content are included in the multimedia content to be displayed by the display unit after the reproduction of the stream media content has ended, and wherein the display unit is operable (a) to display the first content in a case when the reproduction state change information is accepted before (execution of fast forward or fast reverse) the reproduction of the stream media content has ended, and (b) to display the second content in the case where the reproduction state change information is not accepted until the reproduction of the stream media content has ended (Col. 3 line 40-67 and Col. 1-3, following it true when Program file (Multi media content) includes currently played (second content) and preceding or following contents (first content) until the execution of fast forward or fast reverse).

As to claim 9, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the display unit is operable (a) to display the first content (preceding or following content) in a case when the reproduction state change

Art Unit: 2621

information includes one of fast-forward and stop, and (b) to display the second content (currently played content) in a case when the reproduction state change information includes neither of fast-forward and stop (Col. 3 line 40-67 and Col. 1-3).

As to claim 11, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses further comprising a reading unit operable to read, via a storage medium (cache), at least one of the stream media content (content), the multimedia content (program), and the transition condition table (program file) (Figs. 1 and 3).

As to claim 12, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein upon receiving the reproduction state change information (reproduction change to fast forward or reverse) from the reproduction state change accepting unit and changing then state of the reproduction, the reproducing unit is operable to notify the return position determining unit of the reproduction state change information, and after the reproduction of the stream media content is ended, , the return position determining unit is operable to determine the return position based on the reproduction state change information (Col. 3, line 49-67; reproduction of preceding or following content after ending reproduction of currently reproduced content).

As to claim 13, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the return position determining unit holds a state of the reproduction that changes each time the reproduction state change information is received from the reproducing unit, and is operable to determine the return position based on the state of the reproduction after the reproduction of the stream media

Art Unit: 2621

content has ended(each time program file is changed new content with their corresponding URL are provided; Col. 2 line 43-67 and Col. 3 line 1 -20).

As to claim 14, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the display unit holds a state of the reproduction that (reproduction of contents currently reproduced and following contents if a fast forward command is issued) changes each time the reproduction state change information (fast forward or fast reverse command) is received from the reproducing unit, and wherein after the reproduction of the stream media content is ended, the display unit is operable to determine the return position according to the state of the reproduction and notify the return position determining unit of the return position (reproduction of following program instead of currently reproduced; Col. 12, lines 46-63; Figs. 6b and 6c).

As to claim 15, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the reproducing unit holds a state of the reproduction that changes each time the state of reproducing the stream media content is changed (fast forwarding of currently reproduced contents and reproduction of following contents), and is operable, after the reproduction of the stream media content has ended, to determine the return position according to the state of the reproduction (if fast forward reproduce following contents), and to notify the return position determining unit of the return position (URL of following contents)(Col. 12, lines 46-63; Figs. 6b and 6c).

As to claim 17, Terada discloses everything claimed as applied in claim 1 above.

Art Unit: 2621

In addition Terada discloses wherein the return position determining unit is operable to (a) determine a screen for exempting charging, as the return position of the multimedia content, in a case when the reproduction state change information is not found until the reproduction of the stream media content has ended, and determine a screen for charging, as the return position of the multimedia content, in a case when the reproduction state change information change information is found until the reproduction of the stream media content is ended (Fig. 5, shows screen for purchasing contents and delivering of the contents purchased).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,113,983 B1 to Terada et al "Terada" in view of Official notice.**

As to claim 7, Terada discloses everything claimed as applied in claim 1 above. But Terada does not expressly disclose wherein the return position determining unit is operable to determine, as the return position, a default return position that is previously determined in a case when the return position corresponding to the reproduction state change information is not described in the transition condition table. However official notice is taken of the fact that it would have been obvious to one skill in the art to provide a default value for a return position when it is not described in the transition

Art Unit: 2621

condition table. It is very well known in the art to provide default values if some values are not input or not present. Therefore it would have been obvious to one skilled in the art at the time of invention to have been motivated to have a default value incase of the return position is not described.

5. Claims 10, 16, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,113,983 B1 to Terada et al "Terada" in view of U.S. Patent 5,956,037 to Osawa et al. "Osawa"

As to claim 10, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses the ending of reproduction of multi media content and a return position determining unit to determine the return position (Figs. 6a-6c) .But Terada does not expressly, further comprising a reproduction history storing unit that holds a history of the reproduction state change information, wherein upon receiving the reproduction state change information from the reproduction state change accepting unit and changing the state of the reproduction, the reproducing unit is operable to notify the reproduction history storing unit of the reproduction state change information, and to read the history of the reproduction state change information held in the reproduction history storing unit.

Osawa further discloses comprising a reproduction history storing unit which holds a history of the reproduction state change information (Fig. 1b; col. 2 line 26-29), wherein upon receiving the reproduction state change information from the reproduction state change accepting unit (Fig. 6, 601) and changing the state of the reproduction, the reproducing unit is operable to notify the reproduction history storing unit of the

Art Unit: 2621

reproduction state change information, and to read the history of the reproduction state change information held in the reproduction history storing unit (Col. 12 lines 35-55; Col. 13 lines 27-42; Figs. 2 and 6).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Terada with the teachings of Osawa. Motivation to combine would have been to provide a history of contents so that appropriate return position of contents can be achieved so that the appropriate contents according to the return position could be played.

As to claims 16 and 25, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, wherein, after the reproduction of the stream media content has ended(client device acquires another content that precedes or follows currently reproduced contents if a fast forward command is issued by a user), one of the display unit and the reproducing unit is operable to read the state of the reproduction (display unit and reproducing unit reproduces and for example fast forwards) and, to determine the return position, and to notify the return position determining unit of the return position (Col. 12, lines 47-61). However Terada does not expressly disclose a history of the reproduction state change information held in the reproduction history storing unit.

Osawa discloses a history of the reproduction state change information held in the reproduction history storing unit (fig. 1B, 105' or Fig. 6)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Terada with the teachings of Osawa. Motivation to combine would

Art Unit: 2621

have been providing a unit that holds history of operation performed by a user so that an appropriate location of reproduction could be determined.

As to claim 27, Terada discloses everything claimed as applied in claim 1 above. However Terada does not expressly disclose wherein the reproduction state change information includes at least a reproduction history indicating a relationship between the state of the reproduction and time information, and wherein the return position determining unit obtains transition condition information describing a relationship between (a) a return condition defined by the state of the reproduction and the time information and (b) the return position, and determines the return position based on whether or not the reproduction history included in the reproduction state change information satisfies the return condition included in the obtained transition condition information.

Osawa discloses the reproduction state change information includes at least a reproduction history indicating a relationship between the state of the reproduction and time information (Fig. 4 401, History), and wherein the return position determining unit obtains transition condition information describing a relationship between (a) a return condition defined by the state of the reproduction and the time information (Time from FF to play and etc.; Fig. 4) and (b) the return position (defined by time the return position), and determines the return position based on whether or not the reproduction history included in the reproduction state change information satisfies the return condition included in the obtained transition condition information (Fig. 4 return condition is based on time and condition play, ff and etc).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Terada with the teachings of Osawa. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks- Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/A. K./
Examiner, Art Unit 2621